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In re Application of Dane K. Fisher et al. :
Serial No.: 09/394,745 :
Filed: September 15, 1999 : PETITION DECISION
Attorney Docket No.: 16517.001/38- :
21(15454)B :

This is in response to applicants' petition, filed January 10, 2003 under 37 CFR 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on September 15, 1999. The application, as filed, contained claims 1-7. A preliminary amendment canceled claims 1-7 in favor of new claims 8-11. On December 19, 2000, the examiner mailed a restriction requirement dividing the claims into 2 groups, and requiring a further election of a single combination of nucleotide sequences for examination should Group I be elected. In the response filed April 17, 2001 and the supplemental response filed November 30, 2001, applicants elected Group I, claims 8-10, and a combination of 100 nucleotide sequences. Applicants traversed the restriction on the grounds that it would not be a burden to also examine claim 11, nor would it be a burden to search 498 sequences. Applicants argued that they had searched all of the sequences in a short amount of time and had submitted the results of the search on CD-ROM with the preliminary amendment. On March 18, 2002 the examiner mailed a first action on the merits. The examiner agreed to examine all the pending claims but, with regard to the election of a single combination of sequences, made the restriction final, stating that the USPTO conducts its own search using a different methodology. The Office action indicated that SEQ ID NO: 5893 is free of the prior art. Applicants responded on June 18, further arguing that requiring applicants to file multiple applications would pose an undue hardship. In the Office action mailed September 11, 2002, the examiner maintained that the restriction requirement was in accordance with MPEP 803.04. Applicants have filed a Notice of Appeal subsequent to the filing of the petition presently under consideration.

DISCUSSION

Applicants present three lines of argument in the petition. First, applicants argue that the

examiner, by agreeing to also examine claim 11 *at applicants' request*, "essentially rewrote claim 8" into a different format. This argument is not persuasive. The examiner has not rewritten anything. The examiner simply recognized that, having conducted the search for claims 8-10, no further search would be required for claim 11. Absent any additional search burden, there was no reason to maintain the restriction between claims 8-10 and claim 11. Applicants further argue that the claims encompass "thousands upon thousands of various combinations." This is correct. Applicants may claim as many combinations as they wish. So long as the claimed combinations include SEQ ID NO: 5893, they are free of the prior art and no further search would be required to examine such claims.

Next, applicants argue that MPEP 803.04 does not apply in this case. Applicants reason that MPEP 803.04 applies only to claims drawn to a composition (mixtures of nucleic acids), while the invention in the instant application is an article of manufacture (a microarray). This argument is not persuasive. The claimed microarrays are articles of manufacture comprising compositions similar (if not identical) in nature to the compositions discussed in MPEP 803.04. Microarrays *per se* are not new, as shown by the discussion at pp. 59-61 of the specification. The novelty of the claimed invention lies in the nucleic acid sequences present in the array. Therefore the prior art search for the claimed microarrays requires that the nucleic acid sequences be searched, and MPEP 803.04 applies.

Finally, applicants argue that the USPTO uses outdated methodology to search nucleic acid sequences. Applicants magnanimously offer to assist in searching the prior art for the sequences listed in the claims, and point out that the USPTO is considering using prior art searches performed by commercial search authorities in the future. These arguments are not persuasive. At the present time, all prior art searches for U.S. patent applications are performed "in house." The examiner is bound by the rules and policies in place at the present time, as well as the search mechanisms now available to USPTO examiners.

DECISION

Applicants's petition is **DENIED** for the reasons set forth above.

The time period for filing an appeal brief continues to run from the date of the Notice of Appeal.

Since no fee is required for this petition, **the petition fee paid of \$130 will be credited to Deposit Account No. 50-2387, as directed.**

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.

John Doll

Director, Technology Center 1600